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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,490	05/17/2002	Toshiyuki Uehara	L8494.01101	6443

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12  
EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,490

Applicant(s)

UEHARA ET AL.

Examiner

Monique R Jackson

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to because it appears to be a literal translation into English from a foreign document and replete with grammatical and idiomatic errors. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The following is a list of errors noted by the Examiner:

- a. The term "being characterized in that" is not consistent with U.S. practice.
- b. Claim 1 recites the term "it" in line 2 and line 4, however, the term "it" should be avoided given that it is not necessarily clear what "it" refers to.
- c. Claim 1 recites the limitation "the first protective layer" in line 2, "the treatment liquid" in line 3, "the second protective layer" in line 5. There is insufficient antecedent basis for these limitations in the claim.

Art Unit: 1773

d. Claim 1 includes a period at line 8 but no period after the ending of the text at line 18 before the beginning of the subsequent claim, hence it is unclear whether the text after line 8 is part of the claimed invention and for that matter, what exactly is meant to be encompassed by the claim given that a single claim can only comprise one sentence.

e. Claim 1 includes a parenthetical expression at line 13, however it is unclear whether the expression in the parenthesis is meant to be encompassed by the claimed invention.

f. Claims 1, 3 and 4 recite ranges utilizing “~” as opposed to “-” wherein given that the character “~” refers to an approximation, it is unclear whether the ranges recited are meant to be approximations or not.

g. Claim 1 recites the limitation “6,000~1,000,000 in average molecular weight” however it is unclear whether this is number average molecular weight, weight average molecular weight, etc., hence one having ordinary skill in the art would not be reasonably apprised of the scope of the claimed invention and could not interpret the metes and bounds of the claim so as to understand how to avoid infringement.

h. Claim 1 recites the limitation “being produced by using the treatment liquid...the second protective layer of hydro-philic film being produced by adding the treatment liquid containing (c), (d), (e), (f) below and the weight of zirconium in (f) is 40~350% to the weight of vanadium in (e) on the first protective layer and then drying” in lines 3-8 is confusing given that it is unclear whether “the treatment liquid” in lines 3 and 6 refer to the same “treatment liquid” given that there is not differentiation between the two terms, for example, are items (c)-(f) added to the same treatment liquid or are these totally different treatment liquids.

- i. Claim 2 recites the limitation “selected from the group of vanadium acetyl acetate and vanadyl acetyl acetate” in lines 4-5 however it is noted that this limitation is not written in proper alternative or Markush claim format. Though alternative expressions are permissive in the claims, they should be drafted in proper alternative format, i.e. “**selected from A, B or C**”; or in proper Markush claim format, i.e. “selected from the **group consisting of A, B and C**”. A claim that recites “selected from the group consisting of A, B or C” as in the instant claims is improper.
  - j. Claims 3 and 4 recite the limitations “the first protective film” and “the second protective film”, respectively, however it is noted that the parent claim 1 recites “first protective layer” and “second protective layer” hence it is not clear that “the first protective film” and “second protective film” refer to the first and second layers as recited in Claim 1.
4. The Examiner notes that no prior art rejections have been included in this action because the instant claims and the specification are written in a manner such that it is unclear to the Examiner for what invention the Applicant is seeking protection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/980,490

Page 5

Art Unit: 1773

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



**MONIQUE R. JACKSON**  
**PRIMARY EXAMINER**

Technology Center 1700  
September 21, 2003